

## **REMARKS**

### **I. General**

Claims 1-7, 9-11 and 13-19 stand rejected under 35 U.S.C. §103(e) as being unpatentable over Wright et al., United States Patent Number 4,802,218 (hereinafter *Wright*) in view of Block, United States Patent Number 6,010,156 (hereinafter *Block*). Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

Although Applicant does not concede that *Block* is prior art to the present claims, Applicant has set forth arguments distinguishing the pending claims over the disclosure of *Block* because it is believed that such clear distinctions will result in the expeditious issuance of the present claims. However, Applicant expressly reserves the right to contest the availability of *Block* as prior art.

### **II. The 35 U.S.C. § 103 Rejections**

To establish a *prima facie* case of obviousness, three basic criteria must be met, see M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the referenced teachings (or references when combined) must teach or suggest all the claim limitations. Without conceding the second criteria, Applicant respectfully asserts that the references lack all the claim limitations and the proper motivation.

#### **A. The suggested combination lacks all the claim limitations**

##### **1. Independent claims 1, 7, 11, 14, 15 and 16**

Independent claims 1, 7, 11, 14, 15 and 16 recite “a *general purpose processor* based system having a postage printing application program operable thereon . . . .” The Office Action cites *Wright*’s postage meter terminal as teaching this limitation. Office Action pages 3, 6 and 8. However, *Wright*’s postage meter terminal fails to teach a general purpose processor based system. Instead, *Wright*’s postage meter terminal is a *special purpose*

*processor* which securely authorizes and prints postage. Col. 3, lines 4-10. Accordingly, *Wright* lacks the present invention's ability to perform general functions such as accessing the Internet or operating general applications such as word processor "Word" or accounting program "Quicken" as disclosed in the present Application. Application; page 9, line 27 – page 10, line 15 and page 20, line 16 – page 21, line 3. As a result, *Wright* falls short of disclosing a *general purpose processor* based system having a postage printing application program.

Claims 1, 7, 11, 14, 15 and 19 also read "a *general purpose printer* coupled to said general purpose processor based system . . . ." The Office Action cites *Wright*'s Abstract as disclosing this limitation. Office Action pages 3, 6 and 8. However, *Wright* fails to teach a general purpose printer. Instead, *Wright* requires a printer with a microprocessor unit (MPU) containing unique encryption algorithms which parallel those stored on a user card's MPU. Col. 8, lines 21-27. To ensure security, "the print head...can only be operated through the [printer] MPU," and the printer will not print until a secure handshake between the printer MPU and card MPU authorizes a transaction. Col. 8, lines 31-36 (emphasis added). Accordingly, *Wright* requires a *special purpose printer* associated with specific user cards and thereby fails to teach "a general purpose printer" Furthermore, *Wright* exploits the special purpose nature of the printer to increase the security of the system, therefore it would not be obvious to one of ordinary skill in the art to incorporate a general purpose printer into *Wright*'s invention.

Claims 1, 7, 11, 14, 15 and 16 recite "substantially *simultaneously* printing a plurality of postage meter stamps on said sheet" (emphasis added). The Office Action admits that *Wright* fails to teach this limitation and in an attempt to cure this deficiency, cites *Block* as teaching this limitation. Office Action pages 3-4, 6-7 and 8-9. However, *Block* does not teach substantially simultaneously printing a plurality of meter stamps. The Office Action states that *Block* "essentially displays the printing process of stamps on a sheet," but fails to identify any portion of *Block* which discloses the simultaneous printing of a plurality of postage meter stamps. Office Action pages 4, 7 and 9. Accordingly, the rejection of record fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

Furthermore, in contrast to the recited substantially simultaneous printing of meter stamps, *Block* teaches printing labels *consecutively*. For example, *Block* expressly teaches

that “following printing of the integrated field of labels for the item to be mailed, the labels are separated and applied to the item to be mailed . . . .” Col. 5, lines 22-31. Accordingly, *Block* teaches that address, weight, and class data are provided to the computer for processing, and that the data is then sent to the printer which prints labels associated with the item to be mailed. Col. 5, line 33 - col. 6, line 12, and Figure 4. Thereafter, the labels are separated and applied to the item to be mailed. Col. 5, lines 23-24. If the user wishes to mail additional packages, the foregoing steps are repeated, thereby clearly and expressly setting forth consecutive label printing requiring sufficient temporal delay to preclude an interpretation of substantially simultaneous label printing. As a result, the suggested combination does not teach this limitation of claims 1, 7, 11, 14, 15 and 16.

Further still, **claim 7** recites “wherein at least one of said postage meter stamps includes an expiration date of a postage storage device.” Again, the Office Action admits that *Wright* fails to teach this limitation and in an attempt to cure this deficiency, cites *Block*. Office Action pages 6-7. However, *Block* does not teach this limitation. The Office Action states that *Block* “essentially displays the printing process of stamps on a sheet,” but fails to identify any portion of *Block* which discloses at least one postage meter stamp including an expiration date of a postage storage device. Office Action page 7. Accordingly, the rejection of record fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

Moreover, **claim 11** recites “wherein said postage storage device comprises a touch memory utility button.” The Office Action cites *Wright* column 3, lines 25 through 36 and figure 12 as teaching this limitation, however, *Wright* fails to disclose this limitation. Office Action page 8. Instead, *Wright* teaches a card with a microprocessor—not a touch memory utility button. Col. 7, lines 36-50 and Figures 1, 2a, 4, 7, 10 and 12. Accordingly, *Wright* in view of *Block* fails to teach “wherein said postage storage device comprises a touch memory utility button.”

Further yet, **claim 14** recites “wherein said postage storage device comprises a disk coupled to a host processor based system.” The Office Action fails to cite where in the suggested combination this limitation is disclosed. Furthermore, *Wright* in view of *Block* does not teach this limitation. Accordingly, the suggested combination fails to disclose “wherein said postage storage device comprises a disk coupled to a host processor based system.”

As a result, the suggested combination of *Wright* in view of *Block* fails to teach each and every limitation set forth in independent claims 1, 7, 11, 14, 15 and 16. Therefore, Applicant requests withdrawal of the 35 U.S.C. §103(e) rejections of the independent claims.

## 2. Dependent claims 2-6, 9-10, 13 and 17-19

Dependent claims 2-6, 9-10, 13 and 17-19 ultimately depend from independent claim 1 and thus inherit all limitations therein. Accordingly, for at least the reasons advanced above in addressing the rejection of claim 1, each of claims 2-6, 9-10, 13 and 17-19 set forth features and limitations which are not disclosed by *Wright* in view of *Block*. Therefore, Applicant respectfully asserts that claims 2-6, 9-10, 13 and 17-19 are also patentable over the suggested combination and requests withdrawal of the 35 U.S.C. §103 rejections of record. Furthermore, various ones of dependent claims 2-6, 9-10, 13 and 17-19 set forth additional features not taught by the suggested combination.

For example, **claim 4** recites “at least one of said postage meter stamps includes a location from which an item bearing said postage meter stamp is to be posted.” The Office Action cites column 5, lines 1-5 of *Wright* as teaching this limitation. Office Action page 5. However, the cited lines in *Wright* teach validating and refilling the amount on a user card. Col. 5, lines 1-5. Accordingly, as the cited lines fail to disclose the limitations of claim 4, the Office Action has failed to make a *prima facie* case of obviousness. Thus, Applicant respectfully request withdrawal of the rejection of record regarding claim 4.

Likewise, **claim 6** recites “at least one of said postage meter stamps includes a recipient’s ZIP code.” The Office Action cites column 4, lines 64-65 of *Wright* as teaching this limitation. Office Action page 6. However, the cited lines teach a machine reading a postmark to determine whether the postmark was printed by an authorized printer and provide an audit trail. Col. 4, lines 63-65. Accordingly, as the cited lines do not disclose “at least one of said postage meter stamps includes a recipient’s ZIP code,” Applicant respectfully asserts the Office Action has not established a *prima facie* of obviousness and requests withdrawal of the rejection of claim 6.

In another example, **claim 9** recites “at least one of said postage meter stamps includes a unique identification of said postage storage device.” The Office Action cites

*Wright* column 6, lines 42-44 as teaching this limitation. Office Action page 7. However, the cited lines disclose a procedure by which a user card is validated upon entering a serial number into a terminal. Col. 6, lines 40-45. Thus, the cited lines fail to disclose a postage meter stamp including a unique identification of said postage storage device. Accordingly, as the suggested combination fails to teach each and every limitation of claim 9, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of record.

### **B. Motivation**

It is well settled that the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness, M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating the element being combined and then simply restating the same element as the motivation. Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In *re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990), as cited in M.P.E.P. § 2143.01. Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Furthermore, the combination is improper because *Wright* would require substantial modification to meet the required claim. If the proposed modification or combination of the prior art would require a substantial reconstruction and redesign of the elements or change the principle of operation of the reference being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. M.P.E.P. § 2143.01 In *re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In order to execute secure handshake transactions, *Wright* discloses printer 40 executing an internal program which is installed by the terminal's manufacture so that it cannot be tampered with by the outside. Col. 8, lines 16-30. Furthermore, the manufacture embeds the printer MPU 41 in epoxy so that it cannot be accessed without destroying the print head. Col. 8, lines 16-30. Further still, Figure 4 of *Wright* shows printer 40 as non-detachable and located within terminal 20. Figure 4.

In contrast, *Block* discloses using an external, conventional dot matrix printer, thermal printer, or label printer. Col. 4, lines 54-57. Accordingly, modifying *Wright* to incorporate

*Block*'s printer would require substantial reconstruction and redesign of *Wright*. For example, *Wright*'s printer 40 would have to be removed from within terminal 20. Accordingly, printer 40 would have to be redesigned to operate as an external printer and, terminal 20 would need to be reconfigured to operate an external printer. Furthermore, *Block* does not disclose a printer MPU and is not programmable to conduct *Wright*'s secure handshake transactions. Therefore, *Wright*'s invention would have to operate without the required MPU and omit the secure handshake transaction thereby eliminating the principal security operation of *Wright*. Accordingly, as the suggested combination would require substantial modification to *Wright*, the combination is improper.

Moreover, it is improper to combine the teaching of *Wright* with *Block* because *Wright* teaches away from substantially simultaneously printing a plurality of postage stamps. *Wright* teaches an "Auto" mode which prints postmarks on envelopes or labels in *series* rather than in parallel. Col. 12, lines 17-20. Therefore, Applicant asserts that *Wright* teaches away from *simultaneously* printing a *plurality* of metered stamps. As it is improper to modify a reference for an assertion of obviousness where the reference teaches away from the proposed modification, Applicant respectfully points out the suggested combination is improper.

Further still, *Block* also teaches away from the suggested combination. Because *Block*'s invention is intended to prevent affixing the wrong label to the wrong package, *Block* teaches printing and affixing sheet 301 before printing a subsequent sheet. Col. 3, lines 42-45. Applicant therefore asserts that *Block* thereby teaches away from *simultaneously* printing a plurality of meter stamps. As it is improper to modify a reference for an assertion of obviousness where the reference teaches away from the proposed modification, Applicant respectfully asserts the suggested motivation is improper.

Accordingly, the Applicant respectfully asserts the suggested motivation is improper and requests withdrawal of all 35 U.S.C. §103 rejections of the record.

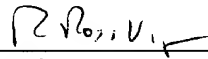
### **III. Conclusion**

In view of the above, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 61135/P004CP1CP1C1/10106025 from which the undersigned is authorized to draw.

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Respectfully submitted,

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